

## **REMARKS**

Claims 1-22 are currently pending. Of these, claims 19-22 have previously been withdrawn from consideration pursuant to a restriction requirement.

### **I. Rejection Of Claims 2-17 Under § 112**

The Examiner rejected claims 2-17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner recites the following support for his position: (1) “The term ‘adapted and configured’ is not defined by the claim;” (2) the specification does not provide a standard for “ascertaining the requisite degree;” and (3) one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. (Office Action at p. 2).

First, there is no requirement in § 112 or the case law interpreting it that a claim contain a definition for any of its terms. The term “adapted and configured” can easily be understood by a skilled artisan.

The Examiner’s second point makes no sense: Of what (or for what) must the specification provide the standard for ascertaining a requisite degree?

Finally, there can be no serious argument that a skilled artisan would not understand the scope of each of claims 2-17 simply because of the use of the structural limitation “adapted and configured” to replace a specified part of the anatomy. When read in light of the specification, the scope of each of these claims is clear. There is no need for these claims to specifically recite any more structure than each of them already does in order to meet the requirements of § 112. The Examiner’s rejection of claims 2-17 under § 112, second paragraph, is inappropriate and should be withdrawn.

### **II. Rejection Under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1, 17 and 18 under 35 U.S.C. § 102(b) as being anticipated by any of Wall US 4,693,712 (“Wall”), Homsy US 4,778,472 (“Homsy”), Morgan US 4,917,701 (“Morgan”) and Zang US 5,314,486 (“Zang”). Wall, Homsy and Morgan disclose temporomandibular joint prostheses. Zang discloses a metatarso-phalangeal joint prosthesis. None of these references discloses a prosthesis having a body accommodating fixation to a

vertebral body at or near a pedicle without support by a lamina and an artificial facet joint structure carried by the prosthesis body adapted and configured to replace a natural articular process of a natural facet joint. Nonetheless, the Examiner somehow reaches the remarkable conclusion that the temporomandibular joint prostheses of Wall, Homsy and Morgan and the metatarso-phalangeal joint prosthesis of Zang are capable of performing the function of replacing a vertebral facet joint. (Office Action, page 4). In fact, however, nothing in any of these references suggests anything of the kind. Claim 1, and claims 2-18 depending from it, are patentable over Wall, Homsy, Morgan and Zang under § 102(b).

### **III. Rejection Under § 102(b) or § 103(a)**

The Examiner rejected claims 2-17 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over, any of Wall, Homsy, Morgan and Zang. In support of this rejection, the Examiner restated nearly word-for-word the argument he used in support of his § 112 rejection of these claims. The standard for rejections under §§ 102 and 103, however, is not the same as for § 112. The Examiner did not indicate where the limitations recited by any of these claims could be found in any of these references. The Examiner has therefore failed to meet his burden of establishing a *prima facie* basis for the unpatentability of these claims. Claims 2-17 are patentable over the prior art of record.

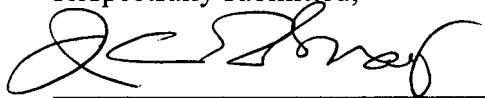
### **Information Disclosure Statement**

A supplemental Information Disclosure Statement accompanies this response.

### **CONCLUSION**

Applicant submits that this paper fully addresses the Office Action mailed May 4, 2007. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned attorney at 650.212.1700.

Respectfully submitted,



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